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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/863,752	05/22/2001	Peter J. Kuzma	9905-20	9127

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EXAMINER

LEE, BENJAMIN C

ART UNIT	PAPER NUMBER
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2632

DATE MAILED: 05/05/2004

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/863,752

Applicant(s)

KUZMA ET AL.

Examiner

Benjamin C. Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5.6</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Status

1. **Claims 1-4** are pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 1-2** are rejected under 35 U.S.C. 103(a) as being unpatentable over Moskowitz et al. (US pat. #5,528,222) in view of Stanfield et al. (US pat. #5,751,221).

1) In considering claim 1:

Moskowitz et al. teaches a radio-frequency identification (RFID) system comprising: a body (passport of Fig. 9) including a pair of covers (passport covers according to col. 6, lines 58-63); and a transponder assembly (Figs. 2-3, 8-10 & 12-13) including: a substrate (220) having a pair of sides; an antenna (230) disposed on one of the sides; a circuit (210) coupled to the antenna and having an identifier code (col. 6, lines 63-67); and an adhesive layer (250) disposed on the other side of the substrate; the transponder assembly being attached to one of the covers by the adhesive (col. 6, lines 62-63 and Fig. 2 including adhesive 250);

Stanfield et al. teaches the known application of RFID devices 120 of unspecified assembly to files 70 by attaching the RFID device to one of the two covers of the file for identification and location tracking of the file according to Fig. 15 and Abstract.

In view of the teachings by Moskowitz et al. and Stanfield et al., it would have been

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obvious to one of ordinary skill in the art at the time of the claimed invention that the specific RFID assembly such as taught by Moskowitz et al. for identifying a passport and its owner would have worked just as well for application to a file for the purpose of identifying the file and tracking location of the file through said identification such as taught by Stanfield et al., and therefore can be used as a specific transponder assembly and mounting/attachment to implement the RFID device in the Stanfield et al. file system.

2) In considering claim 2, Moskowitz et al. and Stanfield et al. made obvious all of the claimed subject matter as in the consideration of claim 1 above, including:

--the claimed embedding of the antenna on one of the covers is met by col. 6, lines 58-60 and Figs. 2-3 of Moskowitz et al.

4. **Claim 3** is rejected under 35 U.S.C. 103(a) as being unpatentable over Moskowitz et al. in view of Stanfield et al. and Isaacman et al. (US pat. #5,936,527).

1) In considering claim 3, Moskowitz et al. and Stanfield et al. made obvious all of the claimed subject matter as in the consideration of claim 1, and:

Stanfield et al. teaches use of a reader (27 in Fig. 2 and according to col. 6, lines 15-24 in combination with Fig. 15) in communication with a plurality of antenna for receiving a transponder response, each antenna being disposed at or near one of the locations of a site for tracking of objects (the RFID embodiment of Fig. 15 when used with a large system of Fig. 2 requiring plural antennas), and an administrator (20 in Fig. 15 of Stanfield et al.) in communication with the reader for receiving information from the reader indicative of the location of the file associated with the transponder assembly transmitting the signal indicative of the identifier code (Abstract);

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while Isaacman et al. further teaches the use of a plurality of antenna arrays for generating an energizing field for providing transponder response to the reader and administrator for identification and location tracking (Figs. 3-4).

In view of the teachings by Moskowitz et al., Stanfield et al. and Isaacman et al., it would have been obvious to one of ordinary skill in the art at the time of the claimed invention that a file tracking system such as taught by Moskowitz et al. and Stanfield et al. when using passive type transponders to track objects over a large area can make use of the energizing field generating and response detecting antenna arrays such as taught by Isaacman et al. for more effective implementation of the intended tracking function by virtue of better coverage provided by the antenna arrays over the large area.

5. **Claim 4** is rejected under 35 U.S.C. 103(a) as being unpatentable over Moskowitz et al.

1) In considering claim 4:

Moskowitz et al. teaches transponder label assembly comprising: a transponder assembly (Figs. 2-3, 8-10 & 12-13) including: a substrate (220) having a pair of sides; an antenna (230) disposed on one of the sides; a transponder circuit (210) coupled to the antenna and having an identifier code (col. 6, lines 63-67); and an adhesive layer (250) disposed on the other side of the substrate;

except specifying the claimed backing sheet releasably attached to the adhesive layer of the transponder assembly.

However, Moskowitz et al. disclosed that in certain applications such as when the transponder is applied to a postage stamp, the bottom surface of the transponder has a pressure sensitive adhesive to bond the stamp to a package or letter envelope (col. 6, lines 38-52. As

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such, it would have been obvious to one of ordinary skill in the art at the time of the claimed invention to use a release backing sheet attached to the adhesive layer, as does conventional stamps having pressure sensitive adhesives, to prevent destroying of the adhesives before it is actually applied to a bonding/labeling surface.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1) Smith et al., US pat. #6,281,795

--A known RFID tag having adhesive on substrate and covered with release liner.

2) Maloney, US pat. #6,204,764

--A similar file tracking system that uses RFID.

3) Fitzgerald et al., US pat. #6,260,049

--A similar RFID file tracking system.


7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin C. Lee whose telephone number is (703) 306-4223.

The examiner can normally be reached on Mon -Fri 11:00Am-7:30Pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel Wu can be reached on (703) 308-6730. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Benjamin C. Lee
Primary Examiner
Art Unit 2632

B.L.
4/29/04